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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/043,153	01/14/2002	Phillip E. Morris	10541-6	5268

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EXAMINER

NGUYEN, TAM M

ART UNIT PAPER NUMBER

3764

DATE MAILED: 02/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/043,153	MORRIS, PHILLIP E.	
	Examiner	Art Unit	
	Tam Nguyen	3764	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) 34-36 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2-8 and 25-33 is/are allowed.
- 6) ☒ Claim(s) 1,9-12 and 15-24 is/are rejected.
- 7) ☒ Claim(s) 13-15 and 37 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 17-20 are rejected under the judicially created doctrine of double patenting over claims 1-4, 6, 12 and 19-21 of U. S. Patent No. 6,612,971 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

2. The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

Morris '971 discloses an exercising machine comprising a movable portion (100) having a rigid member (330) a resisting member (320) configured to apply a resistance to the rigid member as the user moves the movable portion, an adjustment member (390), an overhead frame (110) a front frame (120), a rear frame (130), a roller (200), an axle (210), a support member (410), a skid (430), a wheel (1430) and a handle/knob (390).

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

3. Claims 23 and 24 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 7-18 of U.S. Patent No. 6,612,971.

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Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant application discloses a variable resistance mechanism having a band brake and a knob. Morris' 971 discloses an equivalent variable resistance mechanism having a friction brake (320) and a handle (390). At the time of the invention it would have been obvious to a person of ordinary skill in the art to substitute a friction brake with a band brake and an elongated handle with an knob handle since the friction and band brakes are functionally equivalent in providing a braking means to a rotating disk and the elongated handle and the knob handles are functionally equivalent in providing a force to actuate the braking mechanisms respectively.

Claim Objections

4. Claims 15 and 37 are objected to because of the following informalities:

Claim 15 discloses a "second band brake" and a "second rigid member". This terminology is confusing since a first band brake and a first hub has not been disclosed in this subset of claims. That is, independent claim 12 upon which claim 15 depends has not disclosed either a first band brake or a first hub.

Claim 37, lines 4 and 6, delete "access" and insert --axis--.

Claim 37, line 15, delete "brake system" and insert --brake mechanism--.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(a) as being anticipated by Cheng (6,338,355).

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5. As to claim 1, Cheng discloses an exercise machine comprising a movable portion having a rigid member (30), a braking member (27) biased toward the rigid member, and a pulling member (22) configured to be connected to the movable portion to disengage the braking member from the rigid member when a user moves the movable portion (21 - grip part of the movable portion) wherein the pulling member (22,23) includes a cable (22) that pulls both forward toward the user and rearward from the rigid member in order to disengage the braking member (see Figs. 1-4).

Claim 11 is rejected under 35 U.S.C. 102(a) as being anticipated by Cheng (6,338,355).

6. As to claim 11, Cheng discloses an exercise machine comprising a movable portion having a rigid member (30), a braking member (27) biased toward the rigid member, and a pulling member (23) configured to be connected to the movable portion to disengage the braking member from the rigid member when a user moves the movable portion wherein the pulling member includes a harness assembly (22) (see Figs. 1-4).

Claims 17, 23 and 24 rejected under 35 U.S.C. 102(b) as being anticipated by Eschenbach (5,529,554).

7. As to claims 17, 23 and 24, Eschenbach discloses an exercise machine having a movable portion (54,56, 110) that includes a rigid hub member (110), a resisting band member (108) and a variably adjusting knob member (122) configured to variably adjust the resistance by horizontally moving the resistance member (108) relative to the adjusting member (see Fig. 1).

Claims 21 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Chang (5,108,091).

8. As to claims 21 and 22, Chang discloses an exercise machine having a movable portion (27,34) that includes a rigid member (34), a resisting member (48) configured to apply a resistance to the rigid member as a user moves the movable portion, a variably adjusting member (7), a housing member (47) configured to connect the resisting member and the

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adjusting member wherein the housing member is movable above the rigid member, a tension member (55) is disposed within the housing and engaged to the resisting member wherein the tension member is configured to compress as the resisting member applies a resistance, a counting member (77) and a display member (76) (see Figs. 2 & 6-10).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9, 10, 12, 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cheng '355 in view of Bermel (6,488,130).

9. As to claims 9 and 10, Cheng discloses an exercise machine as described above (see discussion of claim 1). Cheng does not disclose an attachment member and a compression member as substantially claimed. Bermel discloses a machine having a similar braking mechanism that includes an attachment member (76) connected at one end to a braking member/band (70) and connected at the other end to a pulling member (18) wherein the attachment member is configured to transmit the braking force to the braking member from the pulling member, and a compression member (62) connected to and engageable with the braking member/band (70) wherein the compression member (62) is configured to compress as the braking member applies the braking force. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to substitute Cheng's braking mechanism with Bermel's braking mechanism since they are both functionally equivalent in providing a braking force to a rotating rigid member, and the latter mechanism is adjustable to provide varying degrees of braking force to the exercise machine in those instances where the user may want

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some resistance instead of the two extremes of no resistance, where the hub and wheel is free to rotate or so much resistance that the hub and wheel can not rotate at all.

10. As to claims 12, 15 and 16, Cheng discloses an exercise device as described above (see discussion of claim 1). Cheng further discloses a second rigid member (hub of right wheel -30) adjacent to the rigid member (hub of left wheel - 30) and a corresponding resisting member (27) (see Figs. 2 & 3). Cheng does not disclose a variably adjustable band brake member to adjust the resistance of the resistance member. Bermel discloses a machine having a similar braking mechanism that includes a variably adjustable band brake member (70) and a knob (10) (see Figs. 1-5). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to substitute Cheng's braking mechanism with Bermel's braking mechanism on each rigid member since they are both functionally equivalent in providing a braking force to a rotating rigid member, and the latter mechanism is adjustable to provide varying degrees of braking force to the exercise machine in those instances where the user may want some resistance as discussed above.

Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Olschansky et al. (5,284,462).

11. As to claim 22, Olschansky et al. disclose an exercise machine having a movable portion (drive mechanism) that includes a rigid member (72), a resisting member (76) configured to apply a resistance to the rigid member as a user moves the movable portion, a variably adjusting member (80), a housing member (18) configured to connect the resisting member and the adjusting member wherein the housing member is movable above the rigid member (see Figs. 3 and 4). Olschansky does not disclose a counting member and a display member. The Examiner takes Official Notice that the prior art includes exercise devices having a counting member and a display to show the adjustable resistance. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to add a counter

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and a display to Olschansky's machine so that a user can track his efforts against resistance of different levels.

Allowable Subject Matter

12. Claims 2-8, and 25-33 are allowed.
13. Claims 13-14 and 16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tam Nguyen whose telephone number is 571-272-4979. The examiner can normally be reached on M-F, 9-5.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

February 18, 2005



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